

REMARKS/ARGUMENTS

Claims 28-39 are pending. New Claims 28-39 track and find support in prior Claims 9-20. However, the claim language has been revised to provide ample antecedent basis for the various substituents and refer to the groups sequentially as they appear from left to right in the corresponding formulas. Accordingly, no new matter is believed to have been introduced. Favorable consideration of this amendment is now respectfully requested.

Rejection-35 U.S.C. §112, second paragraph

Claims 9-20 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. This rejection is moot in view of the cancellation of these claims.

Rejection-Statutory Double Patenting

Claim 20 was rejected under 35 U.S.C. 101 as claiming the same invention as Claim 1 of prior U.S. Patent No. 6,583,296. This rejection is moot in view of the cancellation of Claim 20. It would not apply to new Claim 39 which corresponds to Claim 20 because the scope of Claim 1 of the '296 Patent is different than that of Claim 39: the ring in Claim 1 of the prior patent has "H" on the N group; the ring in pending Claim 39 has "R".

Rejection-Statutory Double Patenting

Claims 9-19 were rejected under 35 U.S.C. 101 as claiming the same invention as claims 1-18 of prior U.S. Patent No. 6,331,623. This rejection is moot in view of the cancellation of these claims. The differences between the compounds and processes of the '623 patent and the new claims are discussed below in the response to the obviousness-type double patenting rejection.

Rejection-Obviousness-type Double Patenting

Claims 9-19 were rejected under the judicially-created doctrine of obviousness-type double patenting over Claims 1-18 of prior U.S. Patent No. 6,331,623. The formulas in the pending claims differ in structure from those of the prior patent. Notably, Ring P in the present claims has an “R” substituent which is not a heterocyclic group, whereas Ring P in the claims of the ‘623 patent contains “Y”, which is a heterocyclic group. Accordingly, the Applicants request that this rejection be withdrawn.

Rejection-Statutory Double Patenting

Claims 9-19 were rejected under 35 U.S.C. 101 as claiming the same invention as Claims 1-8 of prior U.S. Patent No. 6,371,233. The Applicants believe this rejection refers to U.S. Patent No. 6,271,223, which is listed on Form 892. This rejection is moot in view of the cancellation of Claims 9-19. It would not apply to the new claims for the reasons discussed below in the response to the obviousness-type double patenting rejection.

Rejection-Obviousness-type Double Patenting

Claims 9-19 were rejected under the judicially-created doctrine of obviousness-type double patenting over Claims 1-8 of prior U.S. Patent No. 6,371,233. The Applicants believe this rejection refers to U.S. Patent No. 6,271,223, which is listed on Form 892. This rejection is moot in view of the cancellation of Claims 9-19. It would not apply to the new claims for the following reasons.

Process claims. Only Claim 8 of the ‘223 patent is a process claim. This claim refers to a process for making the compound of formula (Ia) by reacting a compound of formula (III) with a compound of formula (II) and then reacting the resulting product (IV) with the compound of formula (V). Only present Claim 28 (corresponding to prior Claim 9) refers to

a method of making the compound of formula (Ia), however, this claim involves different process steps, i.e., reacting (VI) with (II). The other process claims refer to making different compounds, e.g., of formulas (Ic)-(Ig).

Product claims. Only pending Claims 35, 36 and 39 are product claims. However, the compounds covered by the pending claims are structurally distinct from those of Claims 1-7 of the '223 patent. Claim 35 does not have the -A-Y group required by the '223 patent, Claim 36 has an A-X group and not the -A-Y group of the '223 patent, and Claim 39 refers to the compound of formula (XV) which is quite distinct from formula (I) of Claim 1 of the '223 patent. Accordingly, the Applicants respectfully request that this rejection be withdrawn.

Information Disclosure Statement

The Applicants respectfully request that the examiner acknowledge documents AO and AW cited on form 1449 of the information disclosure statement of July 10, 2003.

CONCLUSION

In view of the above amendments and remarks, the Applicants respectfully submit that this application is now in condition for allowance. Early notification to that effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon


Thomas M. Cunningham
Registration No. 45,394

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

NFO:TMCla